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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,652	10/04/2000	Yoshitada Oshida	500.39147X00	7028

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EXAMINER

SISSON, BRADLEY L

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 11/20/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/678,652

Applicant(s)

OSHIDA ET AL.

Examiner

Bradley L. Sisson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 12-17 and 30-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 18-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 and 18-29 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 is drawn to "a method of inspecting." It is unclear what is being inspected and just what aspect of the unidentified target is the subject of the inspection process. While claim 1 and dependent claims 2-11 do recite method steps, it is unclear how and to what extent these method steps relate to the undefined purpose of the inspection process.
4. Claim 1 is confusing where it is stated: "irradiating mutually different positions" as well as where it is stated: "guiding said generated fluorescent lights from said DNA chip to a fluorescent light detecting optical path." In the latter instance, is it possible that fluorescent light is being guided along a path to a detector?
5. Claims 1, 18 and 19 are confusing where in the method of inspecting culminates with a method step of none other than "executing an inspection of said DNA chip." Seemingly, the method of inspecting comprises the method step of inspecting and could fairly be considered an omnibus claim.
6. Claim 1 is confusing where in the last method step one is to determine what "kind" of DNA is on the chip. It is unclear just what "kinds" of DNA applicant contemplates.

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7. Claim 2 is confusing as to how a single dimension has a fixed pitch. Seemingly pitch of any angle, be it fixed or otherwise is described by at least 2 dimensions.

8. Independent claims 18 and 19 are drawn to "an inspecting method." As set forth for claim 1 above, claims 18 and 19, and claims 20-21, which depend from claim 19, fail to elucidate just what, if any, aspect of the unidentified target is the subject of the inspection process and how and to what extent the recited method steps relate to the undefined purpose of the inspection process.

9. Claim 11 is confusing as to how one irradiates "a second light."

10. Claim 18 is confusing as to how reflecting light upon a surface generates information when one is not required to measure and analyze the reflected light.

11. Claim 19 is confusing as to how one actually "projects images . . . onto . . . a DNA chip." Similar confusion surrounds how these images are to be detected and how these images are extrapolated so to provide information about the chip.

12. Claim 21 is confusing where it is stated: "said branch beans located in a 2-dimensional manner." It is unclear how two dimensions have a manner.

13. Independent claims 22 and 23 are drawn to "an inspecting method of irradiating a sample..." Attention is also directed to the passage that reads in part: "said sample attaching DNA with at least one fluorescent molecule." Such language, especially when read in the context of surrounding clauses, is confusing. It is unclear what target and what property of the target is being inspected. It is further noted that the claimed method does not result in any inspection or determination of any property. Claims 24-27, which depend from claims 22 and 23, fail to overcome this issue and are similarly rejected.

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14. Claims 28 and 29 are directed to "a method of inspecting a DNA chip." While the examiner does appreciate that it is now clear just what is being inspected, the claim does not identify what aspect(s) of the DNA chip are to be inspected. Such limitations are critical to establishing the metes and bounds of the claimed methods. Claim 29 is confusing as to how one changes the position of the "sheet-shaped" light. Is this light still in a sheet form or not, and if it is, is the plane of light still the same. And if this light is used to irradiate a DNA chip, are all of the positions of DNA on the chip in the same plane or are they in essence in three dimensions?

Claim Rejections - 35 USC § 101

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 and 18-29 remain rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. As presently claimed, the methods of claims 1-11 and 18-27 are drawn to a method of "inspecting" but it is less than clear what one is inspecting and what it is being inspected for. While some of the claims do recite method steps that involve a DNA chip, the claims do not culminate in the determination of any specific and useful result. Simply "inspecting" for some unknown quantity in and of its self does not constitute patentable utility. Applicant is reminded that the claims are to be read as broadly as is reasonably possible and that limitations found in the specification are not read into the claims.

While claims 28 and 29 have been amended so to recite that a DNA chip is the target of the inspection, the method does not result in the identification or characterization of one or more properties of the DNA chip that would impart utility to the overall method claims.

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Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

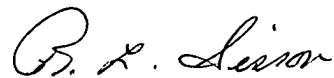
17. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

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20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Bradley L. Sisson
Primary Examiner
Art Unit 1634

BLS
November 18, 2002